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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,686	08/24/2000	Gerald Quapil	31833-150836 (RK)	2565

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

PADMANABHAN, KARTIC

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 08/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,686

Applicant(s)

QUAPIL ET AL.

Examiner

Kartic Padmanabhan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 24-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, drawn to a device, classified in class 435, subclass 287.1.
- II. Claims 24-26, drawn to a method, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus of Group I can be used to carry out processes other than that claimed in Group II. For example, the device of Group I need not be operated in a pulsed mode.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and the search required for one group is not required of the others, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed with the EPO on 8/24/99. It is noted, however, that applicant has not filed a certified copy of the EPO 99 116 534.1 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lekkala et al. (WO 95/22754). The reference discloses a device for carrying out analysis, comprising an analysis well for receiving the substance to be analyzed, a light source (5), and a detector (6). The bottom of the reaction space is coated with a layer of material that can generate an SPR signal. The bottom part of the analysis well is transparent to light. The device also comprises a prism boundary surfaces for the emerging light, as well as for total reflection. The light source is directed through the prism towards the reaction space, wherein the detector is arranged such that it receives light from the prism (abstract). The well of the reference has side walls at angles of

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less than 90 degrees, as seen in the Figures. Further, since the vessel is in the form of a well, it is inherent from the figures that it is a hollow-cylindrical shape with cylindrical bases. The wells of the reference may be in the form of several wells arranged in a row or matrix. The wells can also be arranged in succession in a strip made of plastic in which there are several adjacent wells. These strips can be placed side by side to form the structure of a microtiter plate, such that the strips of wells can be inserted into a housing that holds all the strips to create a microtiter plate structure. The bottoms of the strips can have the shape of any of the prisms (page 5, lines 9-21). The well may specifically be made of polystyrene (page 2, lines 24-25). The measurement of the reference is performed such that a polarized light beam is incident through the prism, and light is totally reflected back into the prism at the boundary surface (page 3, lines 12-35). The light source of the reference may be a laser or LED. The device of the reference further comprises collimating optics and focusing optics (page 4, lines 26-36). When strips of wells are used, the device can comprise a row of light sources and a two-dimensional detector of several detectors as the CCD detector (page 6, lines 10-17). The light must be polarized, such that if the light source does not have its own polarizer, one can be placed between the light source and the prism (page 6, lines 25-28). The well plates and strips of the reference can be fabricated by spray molding using plastic material. Further, instead of assembling separate strips, the plate can be made by molding from a single piece (page 7, lines 3-12).

Response to Arguments

5. Applicant's arguments filed 5/12/03 have been fully considered but they are not persuasive.

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6. In response to applicant's argument that the Lekkala reference does not teach a transmitter *for* emitting light rays that are coupled into the base, etc., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As applicant's invention is drawn to a device, as long as all the components of the device are disclosed by the reference, the claim is anticipated. In the instant case, the reference clearly discloses a transmitter of light; however, as the light rays are not a part of the device, what subsequently happens to the light rays after their transmission is immaterial to the issue of patentability in a device claim, as they are method limitations. Process steps do not merit patentable weight in a claim drawn to a device.

Conclusion

Claims 1-23 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan
Patent Examiner
Art Unit 1641

August 11, 2003



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

08/11/03